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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,421

06/13/2006

Thorsten Schraer

2086/45166/12-PCT-US

6428

279 7590 04/03/2008
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EXAMINER

SAETHER, FLEMMING

ART UNIT

PAPER NUMBER

3677

MAIL DATE

DELIVERY MODE

04/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/596,421	Applicant(s) SCHRAER, THORSTEN	
	Examiner Flemming Saether	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Textron Verbindungstechnik (Germany 200 12 097) in view of Kirrish (US 4,033,243). Assignee's prior patent discloses the features of the bolt including the underside of the head (12) having a threaded cylindrical support (14), webs (22) and a groove (20) wherein the bolt is intended to be pressed into a metal sheet material. However, it does not disclose the underside of the head including a rubber-elastic sealing material. Kirrish also disclose a bolt intended to be pressed into a sheet (see for example webs 68 in Fig. 7 or ribs 59 in Fig. 12) but, Kirrish further disclose a rubber-elastic sealing material (36) received in a groove (40) in the underside of the head (38). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to provide the underside of the head of Textron with a groove provided with a rubber-elastic sealing material as disclosed in Kirrish in order to provide a seal between the bolt and sheet material as discussed Kirrish. The skilled artisan would have recognized to locate the groove radially outside the webs in Textron for the device to remain operative. Finally, the particular sealing materials are all known and would have been obvious to use in the combination.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Textron in view of Kirrish as applied to claim 7 above, and further in view of Damm (US 5,906,463). Damm discloses a sealing material located only at the outer edge of a bolt head (3). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to provide the sealing material of modified Textron only at the outer edge of the bolt head as disclosed in Damm in order to protect that materials while at the same time providing a sealing function as discussed in Damm.

Response to Remarks

The objection(s) and 112 rejection(s) have been withdrawn in response to applicant amendments.

In regards to the rejections over the prior art, applicant argues that it would not have been obvious to combine the sealing feature of Damm with the set fastener of Textron Verbindungstechnik since the sealing material would tend to force the fastener out of the plate. In response, while the examiner disagrees, the rejection of claim 1 did not involve Damm but instead it was Kirrish's sealing feature which was combined with Textron Verbindungstechnik. And, Kirrish includes a fastener which is set into a plate in. But, that notwithstanding, the examiner still disagrees with applicant's argument because the skilled artisan would have recognized to design or engineer the set fastener and sealing feature so as to compensate for the increased forces provided by the seal in order for the device to be operative. The test for obviousness is not whether

the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant further points to the EPO's opinion that a similar combination would not have been obvious. In response, and without going into the facts, the examiner is simply not bound by the EPO's opinion. However, in reviewing the IDS, the examiner found it interesting that the China patent office has an opposite opinion, similar to the above rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 571-272-7071. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Flemming Saether
Primary Examiner
Art Unit 3677

/Flemming Saether/
Primary Examiner, Art Unit 3677